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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2003.10.008.WSO

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on

Signature

Typed or printed name

Nancy Lamberti

Application Number

10/680,949

Filed

October 8, 2003

First Named Inventor

William M. Hurley

Art Unit

2187

Examiner

James R. Golden

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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attorney or agent of record.

Registration number 39,775

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Signature

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July 12, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of 1 forms are submitted.

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DOCKET NO. 2003.10.008.WS0
Customer No. 23990

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : William M. Hurley
Serial No. : 10/680,949
Filed : October 8, 2003
For : APPARATUS AND METHOD FOR EFFICIENT DATA
STORAGE IN A DIGITAL LOGIC DEVICE
Group No. : 2187
Examiner : James R. Golden

MAIL STOP AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal. The review is requested for the reason(s) stated in the arguments below, demonstrating the clear legal and factual deficiency of the rejections of some or all claims.

Examiner Golden rejected claims 1-2, 4-6, 9-10, 12-13 and 15-18 as anticipated by *Joshi, et al.* (U.S. Patent 4,949,301, hereinafter *Joshi*). A prior art reference anticipates a claimed invention under 35 U.S.C. § 102 only if every element of the claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990) *emphasis added*).

Claim 1 requires “circuitry operable to flush the length and the data packet from the memory when the data packet is invalid”. This limitation is not taught or suggested by *Joshi*. Examiner Golden’s analysis clearly illustrates that the teachings of *Joshi* do not show identical elements, and therefore the rejection is both legally and factually deficient.

Examiner Golden refers to *Joshi*’s col. 27, line 61- col. 28, line 20, which discusses flushing an invalid data packet. Examiner Golden states correctly that “the flushing of the length of the data packet is not explicitly recited”, which in itself shows that *Joshi* does not anticipate Claim 1. Examiner Golden concludes, incorrectly, that “the pointer for the next write is set to the address where packet reception started, and this will cause the length of the data and the data to be overwritten on the next write, which is ‘effectively flushing the data’”. This interpretation is not supported in *Joshi*, which expressly states that “no status and length recording step will have been performed in the algorithm at the time that FSHRCVO is asserted” (col. 28, lines 6-8). Since the status and length of the packet have not been recorded at the time the packet is flushed, it is clear that the length is not flushed with the packet. As such, the memory apparatus does not include “circuitry operable to flush the length and the data packet from the memory when the data packet is invalid”, as required by claim 1.

Examiner Golden responds by arguing that “the data packet is ‘effectively flushed’ when the status bit is zero. Joshi’s “effective” flushing does not include the status and length of the packet. Joshi explicitly teaches that, at the time a packet is “effectively flushed,” “[s]ince no status and length recording step will have been performed in the algorithm at the time that FSHRCVP is asserted, the status bit at memory location 1 will still be a zero from the previous packet reception” (col. 28, lines 6-10, emphasis added). The only “effective flushing” that Joshi teaches is performed before the status and length information is written, so it cannot be “effectively flushed”. This is a clear factual deficiency of Examiner Golden’s analysis, repeated in his Advisory Action.

By the Examiner’s interpretation, perhaps some length data is “effectively flushed”, but it is not the length data for the flushed packet. Claim 1 requires circuitry operable to store a length of the data packet and the data packet in the memory; and circuitry operable to flush the length and the data packet from the memory when the data packet is invalid. Nothing Joshi teaches or suggests these limitations.

Independent claim 1 therefore is not, and cannot be, anticipated by Joshi. Independent claims 9 and 15 include similar limitations, and so are similarly not anticipated by Joshi. As the plain limitations of the independent claims are not taught or suggested by Joshi, much less identically, as required by an anticipation rejection, the rejections of these claims are legally deficient.

Further, there is no motivation in the art to modify Joshi to meet this claim limitation, as Joshi teaches away from requiring any such circuitry.

Claims 3 and 11 were rejected as obvious over Joshi in view of Epps *et al.* (US 6,778,546, hereinafter “Epps”). Claims 7-8, 14, and 19-20 were rejected as obvious over Joshi in view of Huang (US 5,311,475, hereinafter “Huang”). These rejections are traversed.

Neither Epps nor Huang teach or suggest the limitation of the independent claims related to “circuitry operable to flush the length and the data packet from the memory when the data packet is invalid”. This limitation is therefore not taught or suggested by Joshi, Epps, Huang, nor any combination of them. The obviousness rejections are therefore also legally and factually deficient.

As described above, Examiner Golden’s rejections of all claims are both legally and factually deficient, and it would therefore be inappropriate to put the Applicant to the time and expense of an appeal at this time.

Other distinctions exist, and there are significant problems with the motivation to combine these particular references, and these matters can be fully discussed on appeal, should that be necessary.

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Customer No. 23990

PATENT

CONCLUSION

As a result of the foregoing, the Applicant asserts that the claims in the Application are in condition for allowance over all art of record, and respectfully requests this case be returned to the Examiner for allowance or, alternatively, further examination.

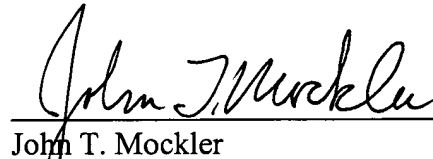
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS P.C.

Date:

12 July 2006



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